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SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			ELAHEE, MD S	
			ART UNIT	PAPER NUMBER
			2645	
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/742,378

Applicant(s)

MARTIN, DANNIE E.

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed 06/14/04. Claims 1-32 are pending.

### ***Response to Arguments***

2. Applicant's arguments mailed on 06/14/04 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the added limitations at this time.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 19, the added limitation "wherein the user ID numbers comprises a temporary ID number that is given by the service when one or more of the at least two chatters is not a subscriber of the service" in page 5 is not disclosed in the original specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 19, the phrase 'the public room' on page 5, line 1 lacks sufficient antecedent basis because it appears that the phrase 'the public room' should be 'the public chat room'.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-6, 8, 11, 15, 16, 18, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721).

Regarding claim 1, Priest teaches receiving a call from a user (i.e., caller) (fig.4; page 4, paragraph 0050, page no 5, paragraph 0052). (Note; telephone user has logged on to server, therefore, it is clear that server receives a call from the user)

Priest further teaches verifying whether the user is a subscriber of the conference or chat room service (i.e., voice chat service) (fig.8; page no 7, paragraphs 0071, 0075). (Note; server determines whether the user wishes to pay for the chat service, therefore, it is clear that server determines whether the user is a subscriber for the chat service)

Priest further teaches providing the user with a series of options (i.e., menu) comprising a conference/chat room (i.e., public voice chat room) selected by the user if the user is a subscriber (fig.8; page no 7, paragraphs 0071, 0075).

However, it is not clear whether Priest teaches a menu comprising two or more public voice chat rooms. Vainio teaches a menu comprising two or more conference groups (i.e., public voice chat rooms) (col.3, lines 55-62). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest to incorporate a menu comprising two or more public voice chat rooms as taught by Vainio. The motivation for the modification is to have doing so in order to provide a list of conference groups so that the user can make a choice based on his interest.

Priest further teaches routing the user to chat room service (i.e., public voice chat room) selected by the user if the user is a subscriber (fig.8; page no 7, paragraphs 0071, 0075).

Regarding claim 2, Priest teaches prompting (i.e., inviting) the user to be a subscriber if the user is not a subscriber (fig.8; page no 7, paragraph 0075). (Note; server prompts the user whether he wishes to pay for the chat service if he has not paid for the service, therefore, it is clear that server invites the user to be a subscriber if the user is not a subscriber)

Regarding claims 4 and 5 are rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 6, Priest teaches providing the user with a user ID number (page 4, paragraph 0050).

Regarding claim 8, Priest teaches retrieving messages (i.e., information) associated with the user (i.e., caller) (page no 5, paragraph 0052).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claims 1, 2, 4 and 8. Furthermore, Priest teaches supplying the user with a series of options (i.e., menu) comprising a conference/chat room (i.e., public voice chat room) that is predetermined by the service (fig.8; page no 7, paragraphs 0071, 0075). (Note; conference/chat room (i.e., public voice chat room) is inherently predetermined by the service)

Regarding claim 15, Priest teaches charging the caller for the voice chat room service (page no 7, paragraph 0075, 0078).

Regarding claim 16, Priest teaches that the charging step is based on time spent by the caller in the one or more chat rooms (page no 7, paragraph 0078).

Regarding claim 18, Priest teaches prompting the caller for a password (page no 3, paragraphs 0039, 0040).

Regarding claim 26 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Priest teaches a plurality of chat sessions (i.e., rooms) (page 1, paragraph 0005, page 3, paragraph 0039).

Regarding claim 28, Priest teaches public chat rooms (page 1, paragraph 0005, page 3, paragraph 0039).

9. Claims 19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone (U.S. Patent No. 6,175,619) and in view of Glenn et al. (U.S. Pub. No. 2002/0021307).

Regarding claim 19, DeSimone teaches facilitating a conversation in a chat room (i.e., public chat room) comprising a plurality of parties (i.e., chatters) (col.5, lines 17-32, 48-63).

DeSimone further teaches leading at least two parties (i.e., chatters) of the plurality of parties (i.e., chatters) in the public room to a chat room (i.e., private chat room) when Participant Authorization Code (PAC) (i.e., user ID numbers) associated with the at least two parties (i.e., chatters) are received (abstract; col.5, lines 17-63, col.6, lines 19-36).

DeSimone further teaches that the Participant Authorization Code (PAC) (i.e., user ID numbers) can be received from one or more of the at least two parties (i.e., chatters) (col.5, lines 17-63, col.6, lines 19-36).

However, it is not clear whether DeSimone teaches “the user ID numbers comprises a temporary ID number that is given by the service when one or more of the at least two chatters is not a subscriber of the service”. Glenn teaches the user ID numbers comprises a temporary ID number that is given by the service when one or more of the at least two users (i.e., chatters) is not a registered user (i.e., subscriber) of the service (page 12, paragraph 0145). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify DeSimone to allow the user ID numbers comprising a temporary ID number that is given by the service when one or more of the at least two chatters is not a subscriber of the service as taught by Glenn. The motivation for the modification is to have doing so in order to send instant messages.

Regarding claim 22, DeSimone teaches that each of the at least two parties (i.e., chatters) must provide his or her own Participant Authorization Code (PAC) (i.e., user ID numbers) to enter the chat room (col.5, lines 17-63, col.6, lines 19-36).

Regarding claim 23, DeSimone teaches that one or more of the user callback numbers (i.e., ID numbers) are permanent callback numbers (i.e., ID numbers) (col.5, lines 17-63).

Regarding claim 24, DeSimone teaches that one or more of the Participant Authorization Code (PAC) (i.e., user ID numbers) are temporary identifications (col.5, lines 17-63, col.6, lines 19-36).

Regarding claim 25, DeSimone teaches that in one or more of the Participant Authorization Code (PAC) (i.e., user ID numbers) can be used only once (col.5, lines 17-63, col.6, lines 19-36).

10. Claims 3, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Harvey et al. (U.S. Patent No. 2002/0059379).

Regarding claim 3, Priest in view of Vainio fails to teach “supplying the caller with a trial membership”. Harvey teaches supplying the user with a trial membership (page 6, paragraph 0059; ‘user’ reads on the claim ‘caller’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow supplying the caller with a trial membership as taught by Harvey. The motivation for the modification is to have doing so in order to provide a chat session.



Regarding claims 10 and 13, Priest in view of Vainio fails to teach “the chat room is moderated”. Harvey teaches that the chat room is moderated (page 6, paragraphs 0057, 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow the chat room be moderated as taught by Harvey. The motivation for the modification is to have doing so in order to add or remove the number of participants in the chat session.

Regarding claim 14, Priest in view of Vainio fails to teach “moderating the one or more chat rooms using rules associated with the voice chat room service”. Harvey teaches that moderating the one or more chat rooms using rules associated with the voice chat room service (page 6, paragraphs 0057, 0059). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow moderating the one or more chat rooms using rules associated with the voice chat room service as taught by Harvey. The motivation for the modification is to have doing so in order to add or remove the number of participants in the chat session.

11. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Dowens et al. (U.S. Pub. No. 2002/0037074).

Regarding claim 7, Priest in view of Vainio fails to teach “routing the user to a private chat room when the user ID number is received from the caller”. Dowens teaches routing the user to a private chat room when the user ID number is received from the caller (page no 6, paragraphs 0062-0065). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of

Vainio to route the user to a private chat room when the user ID number is received from the caller as taught by Dowens. The motivation for the modification is to have doing so in order to participant in the one to one communication so that no body can hear them.

Regarding claim 17, Priest in view of Vainio fails to teach "collecting a fixed fee from the caller regardless of time spent by the caller in the one or more chat rooms". Dowens teaches collecting a fixed fee from the caller regardless of time spent by the caller in the one or more chat rooms (page no 5, paragraphs 0051, 0052). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow collecting a fixed fee from the caller regardless of time spent by the caller in the one or more chat rooms as taught by Dowens. The motivation for the modification is to have doing so in order to bill the user for using the chat session for unlimited use.

12. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Bouvier et al. (U.S. Patent No. 6,430,276).

Regarding claims 9 and 12, Priest in view of Vainio fails to teach "the information can be retrieved from one or more of a home location register, a visitor location register, and a service control point". Bouvier teaches the information can be retrieved from a service control point (col.6, lines 11-13). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow the information to be retrieved from one or more of a home location register, a visitor location register, and a service control point as taught by

Bouvier. The motivation for the modification is to have doing so in order to provide the information of the called party.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone (U.S. Patent No. 6,175,619) and in view of Glenn et al. (U.S. Pub. No. 2002/0021307) and in view of Dowens et al. (U.S. Pub. No. 2002/0037074).

Regarding claim 20, DeSimone in view of Glenn fails to teach “charging one or more of the at least two chatters with additional fees for the private chat room”. Priest teaches charging one or more subscribers for the private chat room (page no 5, paragraphs 0051, 0052). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify DeSimone in view of Glenn to allow charging one or more of the at least two chatters with additional fees for the private chat room as taught by Dowens. The motivation for the modification is to have doing so in order to provide the information of the cost of the chat session.

14. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeSimone (U.S. Patent No. 6,175,619) and in view of Glenn et al. (U.S. Pub. No. 2002/0021307) and in view of Sonesh et al. (U.S. Patent No. 6,614,783).

Regarding claim 21, DeSimone in view of Glenn fails to teach “retrieving one or more of the user ID numbers if the at least two chatters do not remember the one or more of the user ID numbers”. Sonesh teaches retrieving one or more of the user identifications if the at least two users do not remember the one or more of the user identifications (col.6, lines 54-63). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify DeSimone in view of Glenn to allow retrieving one or more of the user ID numbers if the at least two chatters do not

remember the one or more of the user ID numbers as taught by Sonesh. The motivation for the modification is to have doing so in order to provide the information for verification purpose.

15. Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Dowens et al. (U.S. Pub. No. 2002/0037074).

Regarding claim 27, Priest in view of Vainio fails to specifically teach “each of the plurality of chat rooms is associated with a conference bridge circuit”. Dowens teaches that each of the plurality of chat rooms is associated with a conference bridge circuit (fig.5, fig.6; page no 6, paragraphs 0062-0065). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to incorporate each of the plurality of chat rooms associated with a conference bridge circuit as taught by Dowens. The motivation for the modification is to have doing so in order to bridge the conference calls using the bridge circuit.

Regarding claim 31, Priest in view of Vainio fails to specifically teach “moderating conversation in one or more of the plurality of chat rooms”. Dowens teaches moderating conversation in one or more of the plurality of chat rooms (page no 6, paragraphs 0062-0065). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to incorporate moderating conversation in one or more of the plurality of chat rooms as taught by Dowens. The motivation for the modification is to have doing so in order to control the number of participants in the chat rooms conversation.

16. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Morris et al. (U.S. Patent No. 6,339,784).

Regarding claim 29, Priest in view of Vainio fails to teach “private chat rooms”. Morris teaches private chat rooms (col.4, lines 38-41). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow the private chat rooms as taught by Morris. The motivation for the modification is to have doing so in order to provide the access to chat session to all the specific participants.

17. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of DeSimone (U.S. Patent No. 6,175,619).

Regarding claim 30, Priest in view of Vainio fails to teach “leading at least two callers to a private chat room”. DeSimone teaches leading at least two callers to a private chat room (col.5, lines 34-63). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow leading at least two callers to a private chat room as taught by DeSimone. The motivation for the modification is to have doing so in order to provide the chat session to all the particular callers.

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Priest et al. (U.S. Pub. No. 2002/0059138) and in view of Vainio et al. (U.S. Patent No. 6,577,721) and further in view of Trovato et al. (U.S. Patent No. 6,425,012).

Regarding claim 32, Priest in view of Vainio fails to teach “transferring a caller from a first chat room to a second chat room among the plurality of chat rooms”. Trovato teaches adding a caller from a recent chat room to a new chat room among the plurality of chat rooms (col.7, lines 44-56; ‘adding’ reads on the claim ‘transferring’ and ‘recent chat room to a new chat room’ reads on the claim ‘first chat room to a second chat room’). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Priest in view of Vainio to allow transferring a caller from a first chat room to a second chat room among the plurality of chat rooms as taught by Trovato. The motivation for the modification is to have doing so in order to provide the different service based on the caller’s interest.

### *Conclusion*

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burgan et al. (U.S. Patent 6,459,892) teach Method for processing chat messages in a wireless chat device and Will (U.S. Pub. 2004/0147248 A1) teach Recursive identification of individuals for casual collaborative conferencing.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.  
MD SHAFIUL ALAM ELAHEE  
August 26, 2004

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